

## **REMARKS**

### **A. Restriction of Claims 14-16**

In the Office Action mailed on September 9, 2004, claims 14-16 were deemed independent and distinct from the inventions of claims 1-13 and so were withdrawn from consideration as being directed to a non-elected invention pursuant to 37 CFR § 1.142(b) and MPEP § 821.03. Applicants traverse the withdrawal of the claims. Rule 142(b) does not mention automatic withdrawal of claims without a restriction requirement. While MPEP § 821.03 supports the automatic withdrawal of claims as being directed to a non-elected invention, such withdrawal is proper only when it is shown that the new claims are distinct from and independent from the original claims. The tests for determining distinct and independent inventions are set forth in chapter 800 of the MPEP. In the present case, none of those tests have been used to determine whether the inventions are distinct and independent. Instead, the Office Action merely points out that independent claims 1, 11 and 14, 16 have different recitations and provides no analysis as to how the inventions are distinct and independent from one another. Accordingly, the automatic withdrawal of claims 14-16 is improper.

On a related matter, it is noted that that recitations relied on do not accurately reflect the actual language used in one or more of claims 1, 11, 14 and 16. Accordingly, the analysis is flawed for this reason as well.

Despite the impropriety of the withdrawal of the claims, claims 14-16 have been canceled. Note that Applicants reserve the right to file claims 14-16 in a divisional application.

Please note that the cancellation of claims 14-16 is being presented to expedite the issuance of claims 1-13. Since claims 14-16 will be filed in a divisional application, the

cancellation of claims is not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 122 (2002).

**B. Claims 17 and 18**

The Office Action fails to mention claims 17 and 18. Since claims 17 and 18 depend directly on claims 16, it is assumed that the claims are withdrawn for the same reasons given in the Office Action with respect to claim 16. If that is the case, then Applicants object to the withdrawal of the claims for the same reasons given above in Section A.

Despite the improperness of the withdrawal of the claims, claims 17 and 18 have been canceled. Note that Applicants reserve the right to file claims 17 and 18 in a divisional application.

Please note that the cancellation of claims 17 and 18 is being presented to expedite the issuance of claims 1-13. Since claims 17 and 18 will be filed in a divisional application, the cancellation of claims is not being presented for reasons of patentability as defined in *Festo*.

**C. Claims 1-13**

Applicants note with appreciation that claims 1-13 have been allowed.

**CONCLUSION**

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-13 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes

that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorney at (312) 321-4200.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "John C. Freeman", is written over a horizontal line.

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